

No. 7084

IN THE
UNITED STATES
CIRCUIT COURT OF APPEALS
FOR THE NINTH CIRCUIT

THE CHAS. H. LILLY Co. and WILMOT H. LILLY,
Petitioners,

—VS.—

THE DISTRICT COURT OF THE UNITED STATES
FOR THE WESTERN DISTRICT OF WASHINGTON,
NORTHERN DIVISION and THE HONORABLE
EDWARD E. CUSHMAN, JUDGE THEREOF,
Respondents.

**PETITIONERS' BRIEF ON ORDER TO SHOW CAUSE
WHY WRIT OF MANDAMUS SHOULD NOT ISSUE**

JAY C. ALLEN,
WELDON G. BETTENS,
Solicitors for Petitioners.

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Seattle, Washington.

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THE ARGUS PRESS - SEATTLE

FILED

NOV - 9 1934

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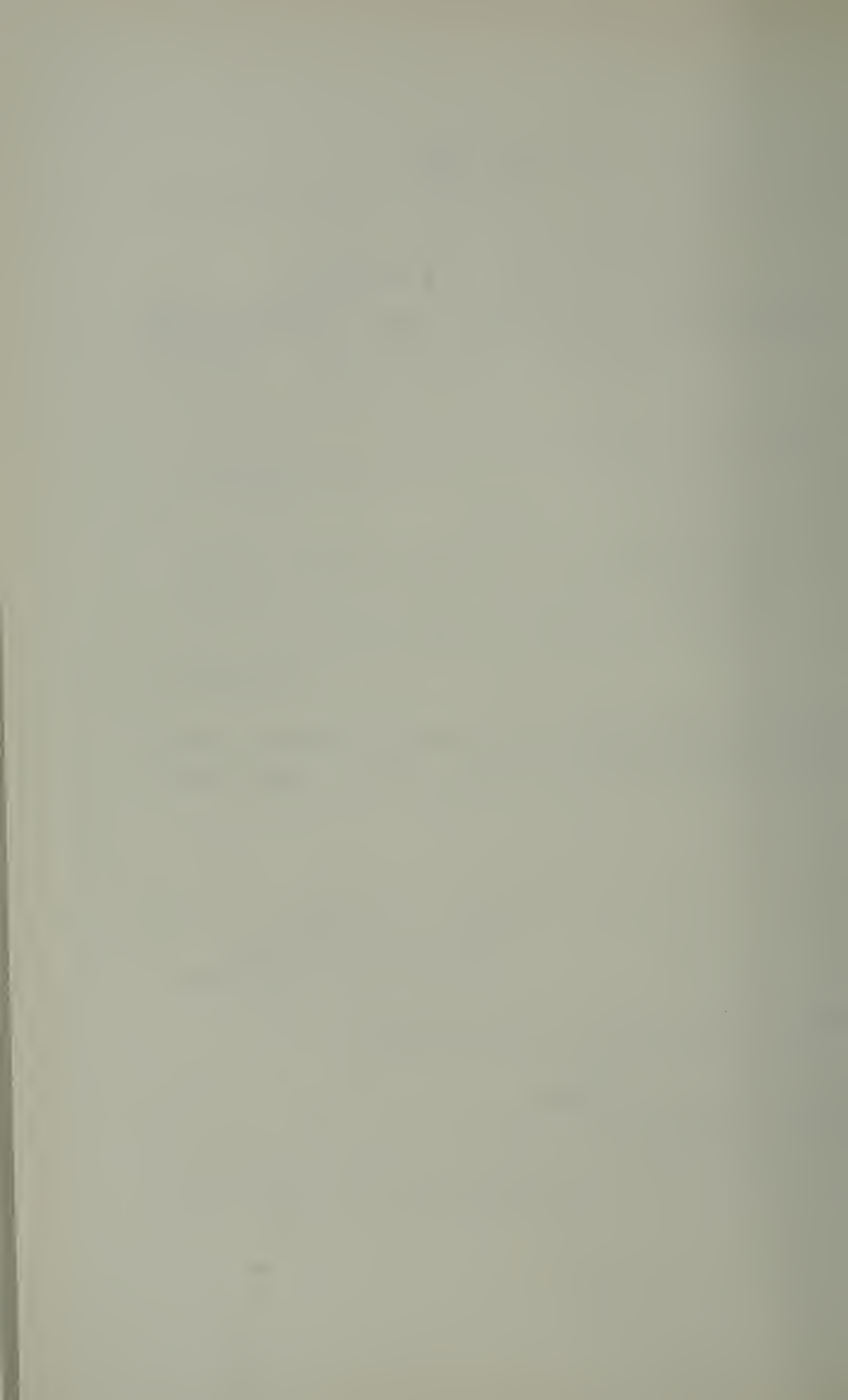
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No. 7084

**PETITIONERS' BRIEF ON ORDER TO SHOW CAUSE
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STATEMENT OF THE CASE

The letter "R.", wherever used in this brief, means the printed "Transcript of the Record" filed herein February 13, 1933, in cause number 7084 in this court. Italics, wherever used, are our own unless otherwise stated. For convenience of expression, we refer in this brief to I. F. Laucks, Inc., the plaintiff below and the appellee in cause number 7084 of this court, as "appellee".

In petitioners' Memorandum of Points and Authorities submitted at the time permission was asked for leave to file the petition for alternative writ of man-

date or prohibition in this court, we pointed out briefly petitioners' objections to the proposed action of the trial court. The objections interposed in the trial court and which are urged in this court are fully set forth in Ex. "G" attached to and made a part of the petition. Among other things, petitioners urge that the proposed action of the trial court will limit the question of petitioners' liability as alleged contributory infringers to acts committed by petitioners prior to the filing of the Bill of Complaint; that it will limit the question of contributory infringement to certain specified claims of the patent and that it makes no disposition of the original decree entered against petitioners, or of the writ of injunction which was issued pursuant thereto, or of the monetary judgment entered against petitioners thereon, all contrary to the opinion, decree and mandate of this court.

In appellee's brief filed for the purpose of inducing this court to refuse permission to petitioners to file their petition, it is contended that the proposed action of the trial court is correct; that the decree on mandate should be limited to acts committed prior to the filing of the Bill of Complaint; that the decree on mandate should be limited to an adjudication with reference to certain claims only of the patent; that a new issue was presented to the trial court calling for the exercise of judicial discretion, and that mandamus is not the proper remedy.

This brief is filed for the purpose of setting forth clearly petitioners' reasons and authorities in support of their position. References will be made to the

transcript of the record before this court on appeal and to appellee's briefs in this court on appeal.

Pleadings and Evidence in Trial Court

Appellee's Bill of Complaint was filed February 14, 1929 (R. 14). Among other things it was alleged in Paragraph IX (R. 12) :

"That said defendants have conspired together to infringe upon said patent rights and each and all of them *refuse to desist therefrom and threaten to continue said infringement* and invasion of plaintiff's rights and intend, unless prohibited by this Court to continue to infringe said Letters Patents * * * ; that the use of said inventions by said defendants and their acts severally and jointly and their *preparation for and avowed determination to continue the said infringing acts*, and their other aforesaid unlawful acts in disregard and defiance of the rights of the plaintiff, have the effect to, and do encourage and induce others to venture to infringe said Letters Patents, in disregard of the plaintiff's rights; all of said alleged infringing conduct having been committed within the six years next preceding the filing of this bill of complaint and within the western district of Washington and elsewhere in the United States. All the aforesaid acts complained of in this Paragraph *are in infringement of each and all of the claims in said Letters Patents on each of which, said plaintiff relies.*"

The prayer, in addition to asking for specific relief,

asked that plaintiff have such other, further or different relief as in equity and good conscience the court should deem meet (R. 13, 14).

Regarding this bill of complaint, Appellee said at pages 104 and 105 of its first answering brief on the appeal:

“Under the bill of complaint in this cause the appellants were charged with the commission of a continuous tort, a continuous wrong doing. The record is that they persisted in this continuous wrong doing up until the very close of the trial in 1931.”

Petitioners' amended answer was filed March 20, 1930 (R. 44). Paragraph VIII of the amended answer (R. 25) set forth among other things the following:

“With respect to Paragraph IX of the bill of complaint, defendants *deny that they have committed or are now committing or threaten to continue committing any wrongful or infringing acts, as further alleged in said paragraph,*”

The amended answer also sets forth the following (R. 43):

“*Defendants deny that they have ever done any act or thing or are doing any act or thing or propose doing any act or thing in violation of any alleged right belonging to the plaintiff or secured to it by letters patents referred to in said bill of complaint or that the said plaintiff is entitled to an injunction either preliminary or perpetual, or to an accounting or to any other relief prayed for in said complaint.*”

Among other things the prayer of the amended answer asked that the defendants have such other and further relief as the premises and the equity of the case might require and as to the court might seem just (R. 43).

Prior to the trial, but after suit had been instituted, on November 25, 1929, appellee and petitioners entered into the following stipulation (R. 103):

“IT IS FURTHER STIPULATED that Chas. H. Lilly Co., the above named defendant, on and before March 27, 1928, sold and delivered *and is now selling and delivering* to the Kaseno Products Co., a co-defendant herein, soya bean seed cake ground to glue specifications, that is eighty mesh or finer, for use in the manufacture of the adhesives or glues of said Company.”

At the trial evidence of claimed infringing acts committed after the filing of the bill of complaint was elicited by appellee. The witness Linquist testified as to several formulas covering glues made by Kaseno Products Company prior to suit, subsequent to suit, and up to the time of the giving of his testimony (R. 209-216). The glue which the trial court held to be an infringement of the Caustic Soda Patent was that which Kaseno Products Company was making at the time the witness, Linquist, gave his testimony (R. 133, 134). The same thing is true with reference to the glue which the trial court held to be an infringement of the Carbon Bisulphide Patent (R. 141), the trial court finding that the viscose contained in the formula was a sulphur compound with properties like those of carbon bisulphide (R. 149). The

specified glues therefore which Kaseno Products Company was making at the time the witness, Linquist, testified, were specifically held by the trial court to be infringements of both the Caustic Soda and Carbon Bisulphide Patents.

Concerning the glues about which the witness, Linquist, testified in general, appellee in its first answering brief in this court said (R. 96):

“We, therefore, respectfully submit that the record in this case unequivocally proves that the Kaseno Products Co. from the time it first commenced to sell soya bean glues *up to the date of trial* did not sell a pound of such glue that did not infringe some or all of the three patents in suit. Every pound infringed claims 3 and 7 of the ‘Johnson’ patent and a great portion of the remainder infringed the claims of the ‘Caustic Soda’ and/or ‘Carbon Bisulphide’ patents found valid and infringed by the court.”

On cross-examination by appellee the witness, Linquist, testified that Kaseno Products Company bought the soya bean flour used for making glues, from the Chas. H. Lilly Company; that the Chas. H. Lilly Company knew that the flour it was selling to Kaseno Products Company in 1927, 1928, 1929 and 1930, was being used by Kaseno Products Company for glue making purposes. That he judged the Chas. H. Lilly Company knew that fact up to the time of the giving of his testimony (R. 216).

The witness, Lilly, on cross-examination by appellee, testified that he knew Kaseno Products Company was using the flour furnished to it to manufac-

ture glue; that he presumed he knew it in 1927; that from 1927 up to the time of the giving of his testimony The Chas. H. Lilly Company had no other larger single customer for soya bean flour of 100 mesh or better than Kaseno Products Company (R. 231).

It will be seen from the foregoing that under the pleadings and the evidence the question of petitioners' liability for acts committed subsequent to the time of the filing of the bill was in issue.

The Trial Court's Decree

The decree of the trial court (R. 156) is attached to and made a part of the petition herein as Exhibit "A". In paragraph I of the decree, by reference, the court found that a wrongful purpose and intent on petitioners' part had been established. It was decreed in Paragraph 6, that Kaseno Products Company and/or George F. Linquist have and/or has infringed each of the two patents in suit with respect to certain designated claims thereof. It was decreed in Paragraph 7, that the defendants, The Chas. H. Lilly Company and/or Wilmot H. Lilly have and/or has contributorially infringed each of said two patents as to the aforesaid claims. In Paragraph 9 it was decreed that plaintiff recover from the four defendants in the action the profits, gains and benefits which said defendants had, respectively, jointly or severally derived, received or enjoyed by reason of said infringement of said claims or which might have accrued to them jointly or severally by reason of said infringement of said claims, and that plaintiff recover

from said defendants either jointly or severally *any and all* damages which plaintiff had sustained or which might be sustained thereafter by reason of said infringing acts.

It will be noted that the decree did not hold petitioners liable only for acts committed prior to the filing of the bill of complaint, but held them liable for *all* alleged infringing acts, including those committed subsequent to the time suit was started.

Appellee's Previous Contentions as to Acts Subsequent to Suit

Appellee now contends that petitioners' acts after the filing of the bill are not material; that evidence thereof was introduced for a limited purpose; that petitioners' liability with reference to such subsequent acts has not been adjudicated and that the trial court was without jurisdiction to adjudicate the question. On the appeal to this court the evidence considered by the trial court was included in the Statement of the Evidence certified to by the trial court and contained in the Transcript of the Record on appeal. On the appeal appellee insisted that this court consider the acts committed by petitioners after the commencement of suit, and hold petitioners liable for such acts. In this connection we quote excerpts from appellee's first answering brief in this court, found in the following designated pages thereof.

"On the 25th day of November, 1929, The Chas H. Lilly Co. entered into a stipulation (Ex. 11, R. 103) that on or before March 27, 1928, it did sell and deliver *and is now selling and de-*

livering to Kaseno Products Co., its co-defendant herein, soya bean cake ground to glue specifications, that is, 80 mesh or finer, for use in the manufacture of adhesives or glues of said company.” (Page 9)

“Kaseno Products Co. started to sell its full seed residue glues in the latter part of 1924 or the early part of 1925. It bought *all* of its soya bean flour from The Chas. H. Lilly Co. with the exception of one purchase from the Fisher Flouring Mill (R. 216).” (Page 17)

“Linguist testifies that their first use of caustic soda with soya bean glues was in March, 1927, and up to February, 1928, caustic soda was used in certain of Kaseno Soya bean glue formulae. From February, 1928, *up to and including the date of trial, May, 1931*, the Kaseno Products Co. used caustic soda as such with lime rather constantly in its glues (R. 215). Kaseno Products Co. first began the use of carbon bisulphide on July 9, 1927 (R. 210). After March, 1928, it used carbon bisulphide directly or indirectly with its soya bean glues (R. 215). * * * It was this glue which the Kaseno Products Co. sold to the veneer industry, according to Linguist’s testimony, from the last of 1926 or the first of 1927, *up to the date of the trial, and continued until the issuance of the injunction by the Trial Court on July 11, 1932* (R. 215).” (Pages 21-22)

“The ‘Appellant Lilly Co.’ furnished *all* of the soya bean flour, *i. e.*, adhesive base, used by the

Kaseno Products Co. from 1926 to the date of trial, save and except one purchase of flour made by the Kaseno Products Co. from the Fisher Flouring Mill (R. 216), and in their stipulation (Ex. 11) they admit furnishing to Kaseno Products Co. the soya bean adhesive base for the manufacture of their glues. (*Italics Appellee's*.)” (Page 25)

“It must be remembered that this case was started on February 14, 1929, and certainly on that date appellants knew they were charged with selling soya bean adhesive base which infringed the ‘Caustic Soda’ and ‘Carbon Bisulphide’ patents. They knew they were charged with acting in concert with Kaseno Products Co. to invade the patent rights of appellee. They knew that the Kaseno Products Co. was using carbon bisulphide and caustic soda in the manufacture and sale of its glues. Does the record disclose that even after such suit and notice that the appellants desisted in the sale of their soya bean adhesive base to Kaseno Products Co.? On the contrary, they continued with such sale up to the very date of the granting of the injunction on the 11th day of July, 1932. *There has not been one argument submitted by counsel for appellants or one authority cited which could or would relieve appellants from the liability for the sale of their soya bean adhesive base to Kaseno Products Co. after the commencement of this present suit February 14, 1929.*” (Page 97)

“Suffice it to say that the record is replete with

proof that appellants knew of the existence of the 'Caustic Soda' and 'Carbon Bisulphide' patents; that they knew or must have known Kaseno was using both caustic soda and carbon bisulphide, *and that they absolutely knew it after this suit was commenced*, because here they were charged with contributorily aiding and abetting in such infringement. Nevertheless, appellants continued to persist with their wrongful sale of their adhesive base up to the date of the injunction granted in the Trial Court. We hesitate to longer impose upon the time of the court to deal with such ill-founded statements of fact and conclusions drawn therefrom." (Page 101)

"Under the bill of complaint in this cause the appellants were charged with the commission of a continuous tort, a continuous wrong doing. The record is that they persisted in this continuous wrong doing up until the very close of the trial in 1931." (Pages 104-105)

"Then, a letter was sent by appellee, giving further notice of patent rights of appellee, and then further suits, including the patents in this suit, were instituted against appellants, yet even after all this, appellants persisted in their contributory infringement, *and this they have done all during the trial, and until positively stopped by the injunction of the Trial Court.*" (Page 129)

The following excerpts are taken from Appellee's second answering brief on the appeal in this court

and are found at the following designated pages thereof:

“Therefore, it follows that the Appellants intended to perform a tortious and unlawful act prior to the commencement of the ‘Johnson’ suit, which tortious and wrongful act at all times continued down to the day of the finding of the Trial Court in its Memorandum Decision on June 15, 1932.” (Page 8)

“But carrying the matter a step further, after the serving of the bill of Complaint in the case at bar, wherein they were actually charged with their unlawful acts, Appellants still do not cease the commission of such wrongful acts, but continue in their performance until the day of the signing of the Memorandum Decision, to-wit, June 15, 1932.” (Page 13)

“We respectfully submit to this Court that the admissions of Appellants as to intent (p. 36, Reply Brief), plus the finding of the Court as to the matter of original intent, plus the now adjudicated fact that the acts of Kaseno Products Co. were wrongful—in which acts the Appellants admittedly aided and assisted — now definitely determine the status of these Appellants *not only as of the date of the commission of the acts, but continuously down to the 15th day of June, 1932*, as that of contributory wrongdoers.” (Page 22)

“We have heretofore directed to the Court’s attention the fact that we did say in our Answering Brief that Appellants had continued

their sale of soya bean flour as a glue base, which we asserted was wrongful, up until the date of the signing of the injunction. This, we there admitted, was outside of the record. We believed it to be true. Appellants now say they continued to sell soya bean flour up until the day of the signing of the Findings of Fact and Conclusions of Law, but stopped on that day. We were evidently in error twenty-six days, that being the difference between the date of the signing of the Findings of Fact and the signing of the Decree. This error in date does not for one moment lessen the culpability of the Appellants *in continuing the use of soya bean flour as a glue base after all the evidence in the trial had been had and pending the ultimate decision of the Court.* Surely, during this period of time Appellants must have had notice and must have been charged with knowledge of the nature and character of their wrongful acts, but still they did not desist. Surely, such conduct shows a deliberate and determined attempt to continue their sale of soya bean flour as a glue base and to reap up to the very date of the decision of the Trial Court all the benefit and profit for themselves as were possible for them to do before being stopped by the Court.” (Page 33)

In Appellee’s petition for a rehearing in this court, among the grounds relied upon in support of the petition was the following:

“9. That this Court in concluding that appellants did not knowingly infringe the patents in

suit, overlooked the notice furnished by the bringing of suit, February 14, 1929, on the 'Caustic' and 'Carbon Bisulphide' patents, and that the appellants continued to furnish soya bean flour to the Kaseno Products Co. after instituting such suit." (Page 6)

In its argument in support of the petition for rehearing, Appellee said:

"As respects ground 9, we submit that appellants, after the bringing of this suit, 7084, on the 'Caustic' and 'Carbon bisulphide' patents, February 14, 1929, had full knowledge by reason of the detailed statements in the Bill of Complaint, of the infringing conduct of the direct infringer, the Kaseno Products Co., and therefore, the continuing to supply said direct infringer with the soya bean flour established beyond a peradventure of a doubt that the said furnishing of the flour was intentional and positive concerting with the Kaseno Products Co. in its infringing conduct." (Page 7)

In Appellee's petition for certiorari filed in the Supreme Court of the United States, which petition was denied on October 8, 1934, Appellee said:

"The Circuit Court of Appeals for the Ninth Judicial Circuit on December 21, 1933, in each of the two cases reversed the decision of the trial court so far as it held respondents liable as contributory infringers." (Page 3)

"The Circuit Court of Appeals for the Ninth Judicial Circuit held that respondents were not contributory infringers of *the patent* in suit and

reversed the District Court, concluding that there were no substantial evidence tending to establish knowledge and intent on the part of the appellants that the product furnished to Kaseno Products Co. was to be used or was being used by the latter for infringing purposes—
 “* * * *that there are no facts and circumstances disclosed from which such knowledge or intent might fairly be inferred or presumed*, and that in the circumstances the appellants were not charged with the duty of ascertaining the character of the use to which Kaseno Products Co. was putting the element furnished to it by appellants (R. 343)’ * * *.” (Page 6)

“Under this decision of the Circuit Court of Appeals for the Ninth Circuit, one who sells an ordinary article of commerce, which is an element of a patented combination, is thereby relieved from *all liability* as a contributory infringer even though such sale be confessedly made with intent to aid and abet in a direct infringement.” (Page 8)

“If this error had not been squarely called to the attention of the Circuit Court of Appeals by the petition for rehearing, it could be said that the second reason might not constitute an adjudication, but when it is remembered that this matter was squarely called to their attention by the petition for rehearing and the petition denied, surely the District Courts of the Ninth Circuit must be bound by this decision of the Circuit Court of Appeals and must con-

sider the same as constituting *an absolute adjudication of the question*, namely, that he who sells an ordinary article of commerce, constituting an element of a patented combination, to a direct infringer, is not subject to injunction or accounting in a suit for contributory infringement, even though such sale be made with knowledge, motive, intent, design and purpose to aid and abet in the infringing act." (Page 10)

Opinion, Decree and Mandate of This Court

The opinion of this court in the case under consideration is reported in 68 Fed. (2nd) 190. The following are excerpts from this opinion which petitioners believe to be particularly pertinent in this proceeding. Among other things this court said:

"The two patents involved in this case are Letters Patent 1,689,732, referred to as the Caustic Soda Patent, and Letters Patent 1,691,-661, referred to as the Carbon Bisulphide Patent. The relation of these patents to the Johnson Patent is explained as follows in the brief of Appellee: 'The Johnson 'Patent' covers broadly the use of soya bean flour as an adhesive base. The 'Johnson' patent may be termed the 'parent' patent, relating essentially to the glue base, while the 'Caustic Soda' and 'Carbon Bisulphide' patents, which relate to improvements in chemicals to be used in connection with the glue base may be termed 'improvement' or 'additional' patents, and are subsidiary to the 'Johnson' patent so far as the same relate to soya bean flour as a

glue base. The 'Caustic Soda' patent teaches, among other things, how to make a 'better glue', using soya bean flour as a glue base. The 'Carbon Bisulphide' patent teaches that an adhesive can be made water resistant with the use of carbon bisulphide."

* * * * *

"Here, as in the Johnson Patent Case, but two of the defendants, namely, Chas. H. Lilly Company and Wilmot H. Lilly, have appealed from the decree in favor of appellee, and the sole question before this court is, Does the evidence sustain the finding that appellant Lilly Company and Appellant Lilly contributorily infringed appellee's patents?"

* * * * *

"The evidence adduced by appellee in support of its charge of contributory infringement in this case is the same as in the Johnson Patent Case, as a reference to the opinion of the trial court will disclose (59 Fed. (2d) 811). A detailed discussion of the evidence in connection therewith would serve no useful purpose, but would merely be a repetition of what is recited in our opinion in the Johnson Patent Case. Here, as in the Johnson Patent Case, the evidence does not, in our opinion, establish that appellants furnished the element in question to Kaseno Products Company with the intent and for the purpose that it would be used in manufacturing *infringing glues*. For the reasons stated in our opinion in the Johnson Patent Case, and on the

authorities there cited, the decree herein *in so far* as it holds appellant Lilly Company and appellant Lilly guilty of contributory infringement of appellee's Caustic Soda Patent and Appellee's Carbon Bisulphide Patent, must be reversed; and it is so ordered." (Italics ours)

The decree of this court is attached to and made a part of the petition herein as Exhibit "B". The decree provides that:

"On consideration whereof, it is now here ORDERED, ADJUDGED and DECREED by this court * * * *that the portion of the decree* of the said District Court in this cause holding appellant Lilly and appellant Lilly Company guilty of contributory infringement of appellee's Caustic Soda patent and appellee's Carbon Bisulphide patent, be, and hereby is reversed, with costs in favor of appellants Lilly and Lilly Company, and against the appellee."

The mandate of this court is attached to and made a part of the petition herein as Exhibit "C". The mandate expressly refers to the decree of the trial court filed July 11, 1932, and expressly makes said decree a part of said mandate. Among other things the mandate provides as follows:

"On consideration whereof, it is now here ORDERED, ADJUDGED and DECREED by this court that * * * *the portion of the decree* of the said District Court in this cause holding appellants Lilly and appellants Lilly Company guilty of contributory infringement of appellee's caustic soda patent and appellee's carbon bisulphide pat-

ent be, and hereby is reversed, with costs in favor of appellants Lilly and Lilly Company and against the appellee.”

* * * * *

“You, therefore, are hereby commanded that such execution and further proceeding be had in the said cause as to said appellants Lilly and Lilly Company in accordance with the *opinion and decree* of this court, and as according to right and justice and the laws of the United States ought to be had, the said decree of the said District Court as to said appellants notwithstanding.”

From the foregoing it will be seen that this court after a careful consideration of all of the evidence adduced by appellee in support of its *charge* of contributory infringement concluded that the evidence did not establish that petitioners furnished the element in question with the intent and for the purpose that it would be used in manufacturing *infringing glues*. This conclusion was reached after the consideration of acts committed by petitioners subsequent to the filing of the bill of complaint as well as those committed prior thereto. After considering the entire matter this court held that, *in so far* as the decree of the trial court held petitioners guilty of contributory infringement of appellee’s caustic soda patent and appellee’s carbon bisulphide patent, it should be reversed.

The decree of this court directed that *the portion* of the decree of the District Court holding petitioners liable as contributory infringers be reversed. The

mandate of this court contained a like provision and directed that further proceedings be had *in accordance with the opinion and decree of this court.*

THE QUESTION OF PETITIONERS' LIABILITY FOR ACTS COMMITTED SUBSEQUENT TO THE FILING OF THE BILL OF COMPLAINT HAS BEEN ADJUDICATED BY THIS COURT.

It will be seen from the foregoing statement of the case that under the pleadings and the evidence the question of petitioners' liability for acts committed after the filing of the Bill of Complaint was in issue. The decree of the trial court held petitioners liable for all infringing acts committed by them. In our brief on the order to show cause issued in cause No. 7083 in this court we pointed out that it was proper for the trial court to have adjudicated the question of petitioners' liability for acts committed after suit had been instituted. In support of that proposition we cited the following cases:

Record & Guide Co. v. Bromley, 175 Fed. 156, 163;

M'Cabe v. Guaranty Trust Co. of New York, 243 Fed. 845, 849;

Equitable Trust Co. v. Western Pacific Railway Co., 244 Fed. 485, 506.

In answer to Appellee's contention that no supplemental Bill of Complaint was filed and that therefore the question of petitioners' liability for acts committed after the commencement of suit was not in issue, we pointed out that the Bill of Complaint alleged a continuing tort and the amended answer denied that

any tort had been committed, or was being committed, or that petitioners intended thereafter to commit any tort. We also pointed out that after the case had been submitted and the decision rendered in Appellee's favor, Appellee tendered to the Trial Court for signature and entry, a decree holding petitioners liable for *all* of their acts, which decree the court signed over petitioners' objections. We contended that under the circumstances the situation was the same as though Appellee had filed a formal supplemental Bill of Complaint. The same argument is applicable in this case. We also pointed out that no supplemental Bill of Complaint was necessary and in support of that proposition, quoted from the following citations:

21 C. J. 543;

City of Denver v. Mercantile Trust Co., 201 Fed. 790, 809, 810;

Richardson v. Green, 61 Fed. 423, 431.

The foregoing authorities are likewise in point in the proceeding in this cause and to avoid repetition we will not extend the argument further.

THIS COURT HAS ADJUDICATED THE QUESTION OF CONTRIBUTORY INFRINGEMENT OF APPELLEE'S PATENTS AND NOT MERELY CERTAIN CLAIMS THEREOF.

As was pointed out in the statement of the case, it was alleged that all of the acts complained of were in infringement of each and all of the claims of the patents, on each of which plaintiff relied. The appeal in this court was a trial *de novo*. This court held

in its opinion that the evidence adduced by Appellee in support of its *charge* of contributory infringement did not establish that petitioners intended that the article furnished by them should be used in manufacturing *infringing glues*.

To avoid repetition we will not here repeat the argument made in our brief in Cause No. 7083 in this connection. We submit that the opinion of this court did not limit the question of contributory infringement to certain designated claims of the patents but was broad enough to cover all claims thereof.

MANDAMUS IS THE PROPER REMEDY

To avoid repetition we will not here repeat the argument made, nor the quotations set forth in our brief in cause No. 7083 in support of our position that mandamus is the proper remedy. In that connection we cited the following cases:

United States v. United States District Court
(C. C. A. 9) 272 Fed. 611;

United States v. Howe, District Judge, 280
Fed. 815;

In Re C. & A. Potts & Co., 167 U. S. 263,
41 L. Ed. 994;

United States v. Swan, 65 Fed. 647;

Delaware L. & W. R. Co. v. Rellstab, 276
U. S. 1, 72 L. Ed. 439;

In Re Beckwith, 203 Fed. 45;

In Re L. P. Larson, Jr. Co., 275 Fed. 535;

Gaines v. Caldwell, 148 U. S., 228; 37 L.
Ed. 432;

- Dubuque & Pacific Railroad Co. v. Litchfield*, 1 Wall, 69, 17 L. Ed. 514;
Ex parte Washington and Georgetown R. Co., 140 U. S. 91; 35 L. Ed. 339;
Wenborne-Carpen-Dryer Co. v. Cutler Dry Kiln Co., 21 Fed. (2nd) 692;
L. Bucki & Son Lumber Co. v. Atlantic Lumber Co., 128 Fed. 332.

AUTHORITIES CITED BY APPELLEE DISTINGUISHED

Appellee, in its "Argument in Support of the Return to the Order to Show Cause", has cited certain authorities which, it is claimed, support the proposed action of the trial court in limiting the decree on mandate to an adjudication with reference to acts committed prior to the filing of the bill of complaint. We will briefly consider each authority so cited.

In *Marsh v. Nicols, Shepard & Co.*, 128 U. S. 605; 32 L. Ed. 538, plaintiff did not have a good patent at the time suit was started, in that a necessary signature had not been subscribed to the document as required by law. During the pendency of the action, plaintiff obtained such necessary signature. The Circuit Court held that until the instrument was properly signed, it was not only defective but was entirely void; that plaintiff could not therefore maintain the suit and it dismissed the bill. In the Supreme Court, plaintiff contended that it was entitled to an accounting, at least from the date on which the

omission had been remedied. In that portion of its opinion relied upon by appellee, the Supreme Court said *that an accounting* for subsequent profits, after suit, could be demanded only where the infringement complained of took place previously and continued afterwards.

There was no showing that the pleadings put in issue the question of claimed infringements committed after plaintiff had secured a good patent; there was no showing that defendants had committed any infringing acts after plaintiff had obtained a good patent; there was no showing that plaintiff gave the statutory notice of its patent after it had secured a good patent; there was no adjudication by the Circuit Court that acts committed by defendants after plaintiff had secured a good patent were infringing acts; there was no decree entered by the Circuit Court holding defendants liable for such subsequent acts. The court simply dealt with the question of an accounting and did not hold that the question of acts committed after the filing of the bill of complaint might not, in a proper case, be adjudicated by the trial court. We submit that the situation in the cited case is not analagous to the situation in the case at bar.

Appellee cites 48 C. J. 323, where the author says:

“It is essential to a cause of action for infringement of a patent that an act of infringement shall have been committed prior to the institution of suit, *or*, where an injunction is asked, that infringement shall at least be actually threatened or reasonably apprehended.”

In support of the first portion of the quoted statement, the author cites *Humane Bit Co. v. Barnet*, 117 Fed. 316 and *Slessinger v. Buckingham*, 17 Fed. 454, both of which cases are cited by appellee and are referred to hereafter.

In *Slessinger v. Buckingham*, 17 Fed. 454, the trial court rendered an oral opinion which is reported in the Federal Reporter, as indicated. The court expressly stated that the evidence was insufficient to show an infringement before the filing of the bill "*or, indeed, an infringement at any time.*"

To establish infringement as alleged, plaintiff sought to prove the purchase and sale of one pair of boots. The court held that there was no showing that defendants made or sold the boots in question prior to the filing of the bill and, furthermore, that "*there is no positive testimony that these boots were made, or sold, by the defendants at all.*" The court held, "The bill is dismissed on the grounds alone of an insufficiency of the evidence to show an infringement, and failure, also, to show an infringement before the filing of the bill."

There is no showing that the pleadings put in issue the question of defendants' liability for acts committed after the filing of the bill. There is no showing that the evidence adduced showed infringing acts after the filing of the bill. On the contrary, the court held that there was no showing of infringement whatsoever.

In *Judson Mfg. Co. v. Burge-Donahoo Co.*, 47 Fed. 463, the opinion was rendered by the trial court. The proof did not show that the defendant either, prior

to suit or subsequent to suit, ever sold, made or manufactured any infringing machines. The court said:

“Respondent never sold, made or manufactured any of the machines. * * * The testimony fails to show, to my satisfaction, that respondent sold or used any of the machines in this district.”

From the foregoing, it is clear, therefore, that there was no proof of any infringing acts committed by the defendant subsequent to the filing of the bill of complaint. There is a positive adjudication that no such acts had been proved.

In *Humane Bit Co. v. Barnet*, 117 Fed. 316, the opinion was rendered by the trial court on defendant's motion made to dismiss the bill on the ground that the act claimed to be an infringement was not committed until after the filing of the bill. The bill was filed October 3, 1894, and alleged that the defendant had made, used or sold bridle bits made, arranged, constructed and combined according to the construction and arrangement set forth in the claims of the patent. To prove the infringement alleged, plaintiff called one witness, who testified that on or about October 5, 1894, he had purchased the device claimed to be an infringement. There is no showing that the pleadings put in issue the question of defendant's liability for acts committed after commencement of suit. Plaintiff took no action which would amount to the filing of a supplemental bill of complaint. The trial court did not attempt to adjudicate the question of whether or not an infringe-

men had been committed after suit had been commenced.

In *Franklin Brass Foundry Co. v. Shapiro & Aronson*, 278 Fed. 435, the opinion of the court relates to the question of an accounting. It developed at the trial that defendant had not been given notice of plaintiff's patent, either constructive or actual, as required by statute, prior to the filing of the bill of complaint. The trial court held that plaintiff was entitled to an accounting in connection with acts committed by the defendant subsequent to the filing of the bill. There is no showing that the question of infringement with reference to acts committed after suit was started was put in issue by the pleadings. There is no showing that the evidence established infringing acts committed after suit started. There is no showing that the trial court adjudicated acts committed after the filing of the bill to have been infringing acts. The trial court simply ordered an accounting broad enough to cover acts committed after suit started. The Circuit Court of Appeals relied upon the case of *Marsh v. Nicols, supra*, in support of its holding that plaintiff was not entitled to an accounting for acts committed after the filing of the bill of complaint.

It is submitted that none of the authorities cited by appellee deal with a state of facts such as are before the court in the instant case and that none of the cited authorities refute the proposition that where the pleadings and evidence put in issue the question of defendant's liability for acts committed after the filing of the bill of complaint, and where the trial

court adjudicated such acts to be infringing acts and held defendant liable for all of such acts, the trial court had jurisdiction to adjudicate the question of defendant's liability in the premises.

CONCLUSION

Petitioners have presented to the trial court for signature and entry a proposed decree on mandate which we submit is strictly in accordance with the opinion, decree and mandate of this court. Appellee has objected to the entry of such decree and has submitted a proposed decree which we submit is not in conformity with the opinion, decree and mandate of this court. The form of decree submitted by appellee attempts to limit the adjudication as to petitioners' liability to acts committed prior to the filing of the bill and to limit the question of contributory infringement to certain claims only of the patent and makes no disposition of the original decree. It is submitted that appellee's proposed decree attempts to restrict the holding of this court and to settle matters passed upon by this court in a manner contrary to the holding of this court. The trial court has definitely indicated that unless otherwise ordered, he will sign and enter the form of decree submitted by appellee.

For the several reasons hereinbefore stated, it is urged that a writ of mandamus be issued by this court, as prayed for.

Respectfully submitted,

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